



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/257,739	02/25/1999	SHALOM Z. HIRSCHMAN	11530-004	2898
20583	7590	04/04/2006	EXAMINER	
JONES DAY 222 EAST 41ST ST NEW YORK, NY 10017			LE, EMILY M	
			ART UNIT	PAPER NUMBER
			1648	
DATE MAILED: 04/04/2006				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/257,739

Applicant(s)

HIRSCHMAN ET AL.

Examiner

Emily Le

Art Unit

1648

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 October 2005 and 20 January 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4 and 7-10 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4 and 7-10 is/are rejected.
- 7) ☒ Claim(s) 1-4 and 7-10 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114 was filed in this application after appeal to the Board of Patent Appeals and Interferences, but prior to a decision on the appeal. Since this application is eligible for continued examination under 37 CFR 1.114 and the fee set forth in 37 CFR 1.17(e) has been timely paid, the appeal has been withdrawn pursuant to 37 CFR 1.114 and prosecution in this application has been reopened pursuant to 37 CFR 1.114. Applicant's submission filed on 01/20/2006 has been entered.

Status of Claims

2. Claims 5-6 are cancelled. Claims 1-4 and 7-10 are pending and under examination.

Specification

3. The disclosure is objected to because of the following informalities:

The replacement paragraph submitted 12/23/2004 recites "between 0 to 100%". It is noted that the submission adopts the suggestion and/or recommendation offered by the previous Examiner of record. However, after an extensive search of the entire specification, the Office cannot find implicit nor explicit support for the cited recitation. What the Office found is adequate support for is 0%, 25%, 50%, 75% and 100%. In the instant, a difference in scope exists between "0 to 100%" and "0%, 25%, 50%, 75% and 100%". The recitation "0 to 100%" includes a scope that is not supported by the specification.

Art Unit: 1648

Additionally, line 20 of page 9 of the specification refers to sodium hydroxide as "Noah". This is an incorrect chemical designation for sodium hydroxide, NaOH.

Appropriate correction is required.

Claim Objections

4. Claims 1-4 and 7-10 are objected to because of the following informalities: The following objections are directed at removing language present in independent claims 1, 7 and 10 that does not contribute to the invention as claimed.

- step h) of claim 1 recites "correlates with a lower level of said expression". To further clarify that the expression of the gene encoding a human immunodeficiency virus coreceptor is of interest here, the Office suggests that the cited recitation be amended to "correlates with a lower level of expression for said HIV coreceptor gene".
- step (iii) of claims 1 and 7 recite "cooling the product" from step (ii)". To provide consistency with the language present in the claims, the Office suggests that the cited recitation be amended to recite "cooling the autoclaved product".
- step e) of claim 7 recites "correlates with a lower level of said expression". To further clarify that the expression of the gene encoding a human immunodeficiency virus coreceptor is of interest here, the Office suggests that the cited recitation be amended to "correlates with a lower level of expression for said HIV coreceptor gene".

Art Unit: 1648

- step g) of claim 10 recites “correlates with a lower level of said expression”.

To further clarify that the expression of the gene encoding a human immunodeficiency virus coreceptor is of interest here, the Office suggests that the cited recitation be amended to “correlates with a lower level of expression for said HIV coreceptor gene”.

- step d) of claim 1 recites “culturing said plurality of groups of said electroporated cells” can be simplified to “culturing said electroporated groups of cells”.
- step g) of claim 1 recites “each of said groups of said cells” can be simplified to “each of said groups of cells”.
- step b) of claim 7 recites “into said plurality of groups of said cells” can be simplified to “into said plurality of groups of cells”.
- steps c) and d) of claim 7 recite “each of said groups of said cells” can be simplified to “each of said groups of cells”.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claim 10 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Art Unit: 1648

The claim requires the quantification of the amount of RT-PCR product produced from cells; and a comparison of the amount of RT-PCR product produced from each of groups of cells. However, the amount of RT-PCR product produced from each of groups of cells was never measured. As noted, only the amount of RT-PCR product produced from cells was measured. Thus, in the absence of the necessary data, a comparison cannot be made among groups of cells.

Additionally, the claim recites "to respective groups of said cultured cells". There is insufficient antecedent basis for "groups of" cultured cells in the claim.

7. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

8. Claims 1-4 and 7-10 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. This is a new matter rejection.

The claims recite the following numerical value: 34.1, 16.7, 21.4, 3.17 2.44 and 16.1. To provide support for these values, Applicant cited line 2 of page 9 to line 8 of page 11 of the specification.

The Office has reviewed the cited passage and the entire specification. However, neither implicit nor explicit support for the cited values can be found the in the specification. Appropriate correction is required.

Additionally, the claims recite "introducing amounts of Product R at concentrations between 0 to 100% to said plurality of groups of cultured cell". The limitation "between 0 to 100%" was introduced in the claims via Applicant's 02/12/02 (signed by Applicant's representative on 01/31/2002) submission.

It is noted that the submission adopts the suggestion and/or recommendation offered by the previous Examiner of record. However, after an extensive search of the entire specification, the Office cannot find implicit nor explicit support for the cited recitation. What the Office found is adequate support for is 0%, 25%, 50%, 75% and 100%. In the instant, a difference in scope exists between "0 to 100%" and "0%, 25%, 50%, 75% and 100%". The recitation "0 to 100%" includes a scope that is not supported by the specification. Appropriate correction is required.

Conclusion

9. No claims are allowed. The claims are free of the prior art. Thus, the claims would be allowable upon the submission of a response that overcomes the issues raised herein.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Emily Le whose telephone number is (571) 272 0903. The examiner can normally be reached on Monday - Friday, 8 am - 5:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Housel can be reached on (571) 272-0902. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 1648

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Jeffrey S. Parkin, Ph.D.
Primary Patent Examiner
Art Unit 1648



E. Le